

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-18 are pending, with Claims 1-6 amended and Claims 7-18 added by the present amendment.

In the Official Action, Claims 4 and 6 were objected to; Claims 1 and 6 were rejected under 35 U.S.C. § 102(a) as being anticipated by Yamamoto (JP 2002-300655 A or 2002-215586 A, corresponding to U.S. Patent Publication No. 2005/0108520); Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Takae (U.S. Patent Publication No. 2004/0087337); and Claims 2 and 3 were indicated as containing allowable subject matter.

Applicants acknowledge the appreciation indication of allowable subject matter.

Claims 1-6 are amended cosmetically to improve grammar and to overcome the outstanding objection. Claim 5 is also amended to comply with MPEP 2164.08(a). Support for these amendments is found at Applicants' originally filed specification.¹ No new matter is added. Claims 7-18 are apparatus and method claims corresponding to means plus function claims recited in original Claims 1-6. No new matter is added.

Briefly recapitulating, amended Claim 1 is directed to a mail server for delivering to a mobile communication terminal electronic mail addressed to the mobile communication terminal. The mail server includes recording means for recording an address identified by the mobile communication terminal as a recorded address; comparing means for comparing *a transmission source address in an electronic mail addressed to the mobile* communication terminal with the recorded address recorded by the recording means; and delivery means which, when the recorded address and the transmission source address match according to the

¹ Specification Figure 4.

comparison performed by the comparing means, deliver electronic mail comprising this transmission source address repeatedly to the mobile communication terminal.

Yamamoto describes an authentication apparatus for providing security when access is requested from a mobile phone. In Yamamoto, when there is an access request from the mobile phone, an authentication server transmits a program to the mobile phone. The program reads data regarding an individual number (e.g., serial number) recorded in a scratch pad of the mobile phone and transmits the data to the authentication server. The authentication server receives the data regarding the serial number transmitted by the activation of the program and compares the serial number with data in the authentication of server. When the serial number matches any of the serial numbers maintained in the authentication server, the authentication server authenticates the access to be valid.² However, Yamamoto fails to disclose or suggest “comparing means for comparing a *transmission source address in an electronic mail addressed to said mobile* communication terminal with said recorded address recorded by said recording means” as recited in amended Claim 1.

As shown in Figures 13 and 14 of Yamamoto, the mobile of Yamamoto transmits user identification information to the authentication server. The authentication server authenticates the mobile and, if authenticated, sends a registration email to the mobile. After authentication, a port is opened to allow communications to and from the mobile. In contrast, in Applicants’ claimed invention, the user of the mobile causes data corresponding to an external email address to be registered in a proxy server. If an email is received from that registered external email address by a proxy server, the proxy server repeatedly forwards the email to a mobile device of the user.

² Yamamoto Abstract; Figure 13.

In addition, Yamamoto fails to disclose or suggest “identification information attachment means which, when the recorded address and the transmission source address match according to the comparison performed by the comparing means, attach to an electronic mail comprising this transmission source address automatic opening identification information serving as a trigger for implementing processing to cause the mobile communication terminal to automatically open the electronic mail upon reception of the electronic mail” as recited in Claim 4.

MPEP § 2131 notes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Yamamoto does not disclose or suggest all the features recited in Applicants’ independent claims, Yamamoto does not anticipate the invention recited in Applicants’ independent claims, and all claims depending therefrom.

Applicants have also considered Takae and submit Takae does not cure the deficiencies of Yamamoto. As none of the cited prior art, individually or in combination, disclose or suggest all the elements of Applicants’ independent claims, Applicants submit the

inventions defined by Applicants' independent claims, and all claims depending therefrom, are not rendered obvious by the asserted references for at least the reasons stated above.³

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
BDL/MEM:aif



Bradley D. Lytle
Registration No. 40,073

Michael E. Monaco
Registration No. 52,041

I:\ATTY\MM\245636US-AM1.DOC

³ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."